

REMARKS/ARGUMENTS

Claims 1-36 remain pending in the application. Claims 1-36 are rejected. Though this Amendment and Response, Applicants have amended claims 1, 18 and 35 – 36 and cancelled claims 6 and 23. No new matter has been introduced into the application. As explained in more detail below, the Applicants submit that all claims are now in condition for allowance and respectfully request such action.

Interview Summary

This Interview Summary is filed further to the Examiner's Interview conducted with Examiner Tran on April 26, 2007.

Applicants wish to thank Examiner Tran for the telephone interview on April 26, 2007, during which the pending claims (claims 1-36) were discussed. During the interview, Applicants and the Examiner discussed the teachings of paragraphs 1, 6, 15, 35, 40 and 41. No agreement was reached.

Rejections under 35 U.S.C. §103

Claims 1-2, 4-5, 7-9, 15-19, 21-22, 24-26 and 32-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (U.S. Pat. Pub. No. 2003/0043974) in view of Lautenschlager et al (U.S. Pat. No. 6,970,543). The Applicants request reconsideration in view of the Remarks below.

The Examiner does not believe the limitation "transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user's contact database" is supported in the Specification. Specifically, the Examiner believes that the cited portions of the Specification do not teach or suggest that "the caller identity is transmitted before placing a call." (Advisory Action dated April 17, 2007, page 2). Applicants respectfully disagree with the Examiner's position, as described in paragraphs 1, 6, 15, 35, 40 and 41 of the Specification.

Applicants respectfully submit that the claims are distinguishable from the prior art and are clearly supported in the Specification. For example, as provided in the Specification "a user

can select his or her own identifier, automatically transmit it to a set of applicable users, and store all associated files or aspects of the identifying information in the receiver's database." (Para. 6) Also paragraph 35 provides: "[t]he forwarding of the information from table 325 may occur in a variety of ways and at a variety of times. For instance, the information in table 325 may be forwarded to the called party (Kinny 315) when the information in table 325 is modified or some later time (for example, at night or on the weekends when traffic is low)."

Further, such a background process that transmits the caller identification without having to call (or otherwise attempt to communicate directly with) the called party is more completely described at paragraphs 39-42. As provided in the Specification:

When receiving a new identifier, the database may automatically trigger a background transmission process that sends the new identifier to at least one of the applicable contacts as is described in step 420. The background transmission process may also be triggered manually, permitting the user to control when to send new information out to a contact list. The applicable contacts could be everyone within a user's contact database 305 (Figure 3) or only certain set of selected users... One advantage of using a background process may be that the user does **not** have to update each individual contact when he or she calls the person. Instead, the transmission of the update is performed before communications are ever established. Another advantage of such an implementation may be that the background process may take advantage of periods of low network activity and therefore efficiently utilize communications bandwidth. (Spec., para. 40 and 41).

Claims 1, 18, 35 and 36 have been amended to indicate the caller identification is transmitted "through a background transmission process" to further reiterate the claim language already present in claims 1, 18, 35 and 36 that the caller identification is transmitted "before initiating communication with a second user." Indeed, as explained in the Specification, the background process is any process that may be carried out to transmit the identification information before initiating communication with a second user. As discussed in the previous responses, transmitting the caller identification before initiating communication with a second user (using a background transmission process) is not taught, suggested, or discussed anywhere in the art of record, whether individually or in combination. Therefore, for at least this reason, Applicants respectfully request reconsideration and withdrawal of the rejection.

Through this Response and Amendment, Applicants have also amended claims 1, 18, 35 and 36 to remove the limitation "upon selection of the caller identification" from the transmitting

element of the claims to more clearly indicate the caller identification is transmitted anytime “before initiating communication with a second user.” As provided in the Specification, [t]he background transmission process may also be triggered manually, permitting the user to control when to send new information out to a contact list...Another advantage of such an implementation may be that the background process may take advantage of periods of low network activity and therefore efficiently utilize communications bandwidth.” (Paragraphs 40 41).

The claims as presently presented are distinctly different than Emerson, which requires communication between two parties to be initiated or established before transmitting identification information. For example, paragraphs 0039 and 0040 of Emerson set forth the transmission of profile information in a canned message to be transmitted, for example, as combined with E-card, in which the E-card “can be sent to the called system during call setup”. (Paragraph 0040; emphasis added). Indeed, transmitting profile information is performed in the context of initiating contact, such as a call, with another user. (See also paragraph 0035; stating “user profile information is sent to and exchanged with corresponding systems in the call setup process, particularly in the circumstance of a failed call setup attempt due the called party not answering”; emphasis added); and paragraph 42 (the E-card may alternatively be “passed to the other party on demand after call setup”). Further, there is no teaching in Emerson of transmitting the first user’s selected caller identification “to a list of contacts selected from the first user’s contact database”. As discussed above, Emerson shows the transmitting of information to a called party. There is no teaching to transmitting the identification to a list of contacts, but rather only to the called party.

Applicants further respectfully submit that Lautenschlager, either individually or in combination with Emerson or any art of record, does not teach the subject matter of the rejected claims. Rather, Lautenschlager discloses transmitting the caller identification in the context of a call setup process, as disclosed by Emerson. As expressly stated in Lautenschlager:

The object of the present invention, therefore, is to create a convenient identification of the call of a subscriber calling, via a telecommunication network, a destination telecommunication device of a called subscriber.

(Col. 1, ll. 47-50; emphasis added) This is further apparent within the sections of Lautenschlager cited by the Office Action.

This invention is based on the concept that the destination telecommunication device, in particular, a destination terminal, receives the identification data within a call setup signalling message and outputs this or, if applicable, output data generated from it, as acoustic and/or visual and/or mechanical call signals instead of an acoustic call tone selected by the destination telecommunication device. Instead of the called subscriber hearing an arbitrary ringing tone or a call melody which, although they may each be specifically set on the called subscriber's terminal, nevertheless do not contain any indication of the source of the call, the incoming call is signalled through individual and personal signals which are assigned to the caller and are selected by the latter.

(Col. 1, ll. 53-67; emphasis added) As also disclosed in Emerson, the call setup message of Lautenschlager takes place in the context of a call (i.e. after initiation of communication).

The identification data for call identification can be transmitted directly from the source telecommunication device of the caller to the destination telecommunication device of the called subscriber, for example, in a call setup message.

(Col. 2, ll. 23-26; emphasis added)

Therefore, for at least these reasons, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 3 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Awada et al. (6,873,861).

As discussed in detail above, neither Emerson nor Lautenschlager discloses or otherwise suggests at least “transmitting, before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Awada, which is directed towards transmitting business cards during a phone call. Moreover, claims 3 and 20 further limit the element “selecting, by a first user, a caller identification associated with an identity of the first user” as recited in the claims. In contrast, the cited text of Awada concerns the transmission after a business card has already selected and stored. For at least these reasons, combining

Emerson with Awada does not suggest the subject matter of the rejected claims. The Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection.

Claims 6 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Morkel (US 2002/0052921).

In response, the Applicant submits the rejected claims as presently provided are not obvious in view of the cited references. As discussed in detail above, neither Emerson nor Lautenschlager discloses or otherwise suggests at least “transmitting, before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Morkel. The Office Action asserts that Morkel teaches transmitting the Caller ID to the list of contacts (page 1, para. 0007, page 2, para. 0011, and page 3, para. 0035) for the purpose of securely acquiring, handling, and maintaining contact information (page 1, para. 0002 and 0006). The cited paragraphs do not read upon the rejected claims. For example, claim 6 recites:

The method of claim 1, wherein the step of transmitting, upon selection, the caller identification to a list of contacts selected from the first user’s contact database further comprises:

transmitting the caller identification to the list of contacts through a background transmission process.

In contrast, the cited text of Morkel sets forth that a user can attach a message to an email directed to a recipient indicating that personal information is included in the message (para. 7, 11, and 35). Therefore combining Emerson with Morkel does not suggest the subject matter of the rejected claims, therefore, for at least these reasons the Applicant respectfully requests reconsideration and withdrawal of the rejection. In the alternative, the Applicant requests clarification on where Morkel teaches such a background transmission process and how one skilled in the art would have been motivated to make such a combination.

Claims 10 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Beaton et al. (6,442,263).

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, neither Emerson nor Lautenschlager discloses or otherwise suggests at least “transmitting, before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Beaton.

Therefore combining Emerson with Beaton does not suggest the subject matter of the rejected claims, therefore, in view of the foregoing, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 11-14 and 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Toyryla et al. (US 2003/0083086).

In response, the Applicant submits the rejected claims as presented are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, neither Emerson nor Lautenschlager discloses or otherwise suggests at least “transmitting, before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Toyryla. Indeed, the cited text merely states that groups “may be created and managed by sending standard messages, i.e. in a way similar to distributing electronic business cards (and ringtones and logos).” (Page 3, para. 0042). Merely teaching that groups may be created by sending standard messages does not teach or otherwise suggest the subject matter of the rejected claims. Therefore, Applicants respectfully requests reconsideration and withdrawal of the rejection.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: May 24, 2007

By: /Shawn Gorman/
Shawn P. Gorman
Reg. No. 56,197

BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
Chicago, IL 60606
Tel: (312) 463-5434
Fax: (312) 463-5001